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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/504,827

02/18/2005

Evelyne Bonnet

154322

2023

34132 7590 04/08/2008

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EXAMINER

CAMERON, ERMA C

ART UNIT

PAPER NUMBER

1792

MAIL DATE

DELIVERY MODE

04/08/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/504,827 | <b>Applicant(s)</b><br>BONNET ET AL. |  |
|                              | <b>Examiner</b><br>/Erma Cameron/    | <b>Art Unit</b><br>1792              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13, 14, 17 and 23-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13, 14, 17 and 23-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/8/2005</u> .  | 6) <input type="checkbox"/> Other: ____.                          |

### **DETAILED ACTION**

The examiner notes the following errors in the status identifiers:

- a) claim 10 is amended but is given the erroneous status identifier “previously presented”.
- b) claim 13 is amended, but is given the erroneous status identifier “previously presented”.
- c) any claim (for example, claim 3) that is exactly as originally filed should have the status identifier “original”.

### ***Claim Objections***

1. Claim 25 is objected to because of the following informalities: lacks a period.  
Appropriate correction is required.
2. Claims 1 and 10 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Both claims contain material already present in independent claim 1.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-11, 13-14, 17 and 23-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claims 1, 13 and 23: “diamine-type” is vague and not well defined. Is the chain extender a diamine or not?

b) Claim 1 and 23: it is not clear what is meant by “simple”.

c) Claim 1, 13 and 23: it is not clear if the hydroxylated polydiene is the same or different from the diol.

d) Claim 2: ”at said polyol” does not make sense.

e) Claim 4: “claimed claims 2” does not make sense.

f) Claims 23 and 24: it is not clear if “tie layers” modifies “carpet underlay” or not.

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g) Claim 24: should not claim a coating per se. Only a composition or a coated material may be claimed, not a coating alone. A coating is associated with the article coated. Ex parte Scott 66 USPQ 371.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-11, 13-14, 17 and 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lalanne et al (4724245) taken in view of WO 99/48941.

‘245 teaches an asphalt-polyurethane, shelf-stable, aqueous emulsion composition to be used in coatings (see Abstract). The polyurethane composition contains a hydroxylated polybutadiene (2:44) and a polyol (3:19), as well as a polyisocyanate (3:15-29). Although ‘245 does not teach the solids content for either the polyisocyanate or the asphalt, ‘245 does teach 15-120 parts of polyisocyanate emulsion to 100 parts of asphalt emulsion (3:41-46), which meets the limitations of claims 11 and 14.

‘245 does not teach the aqueous polyurethane dispersion prepared as claimed in independent claims 1, 13 and 23.

WO'941 teaches an aqueous polyurethane dispersion as claimed in claims 1, 13 and 23, and which also meets the limitations of claims 2-10 and 23-27.

Flat et al (US2003/0069380) is used as the translation of WO 98/48941.

'380 teaches an aqueous urethane dispersion formed from a polyisocyanate, a hydroxylated polydiene with a Mn of at least 2000 and a OH number of 0.5-1.5 (such as polybutadiene), a diol with neutralized acid groups (dimethylolpropionic acid), and a diamine chain extender. The NCO/OH ratio is 1.5-2.5 (see Abstract; [0011]-[0022], [0026], [0040]).

It would have been obvious to one of ordinary skill in the art to have substituted the polyurethane dispersion of '380 for the polyurethane dispersion of '245 because of the teaching of '380 that coatings made with their polyurethane dispersion have good moisture resistance, and that coatings made with the dispersion are flexible at low temperatures, both of which would be desirable properties for the '245 coatings.

7. Claims 1-11, 13-14, 17 and 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 92/18558.

'558 teaches a polyurethane-asphalt coating mixture prepared from an isocyanate prepolymer formed from a polyisocyanate, a hydroxylated polybutadiene, a diol with neutralized acid groups (dimethylolpropionic acid neutralized with trimethylamine), and a chain extender such as hydrazine or ethylene diamine. This is mixed with an asphalt emulsion at 3-40 wt% of urethane and 10-94% asphalt emulsion. The NCO/OH ratio is 1.6-2.4. The other properties appear to overlap with applicant's claimed properties. See pages 4-18 and 21.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Erma Cameron/ whose telephone number is 571-272-1416. The examiner can normally be reached on 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Erma Cameron/  
Primary Examiner  
Art Unit 1792

March 30, 2008